The opinion in support of the decision being entered today was not written for publication and not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THORSTEN OTT and CHRISTIAN GOLDBACH

Appeal No. 2004-0335
Application 09/586,214

ON BRIEF

Before COHEN, ABRAMS, and FRANKFORT, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

The above identified application is being remanded to the examiner under the authority of 37 CFR § 1.196(a) and MPEP § 1211 for appropriate action with regard to the items listed below.

Claims 1, 2 and 8, all of the claims remaining in this application, stand rejected under 35 U.S.C. § 103(a) as being obvious over Sigl (U.S. Patent No. 5,794,735). Independent claim 1 is directed to a method for controlling a vehicle and includes, *inter alia*, the steps of "detecting whether the vehicle is traveling on a descent; calculating at least one manipulated variable based on the actual speed and the setpoint speed only when the vehicle is detected as traveling on the descent; and influencing the actual speed of the vehicle on the basis of the at least one manipulated variable." Claim 2 depends from claim 1 and adds the requirement that at least one manipulated variable is calculated "only when one of a switch and a button is activated." Independent claim 8 is directed to a device for controlling a vehicle and includes a control device, a memory in which a set point speed is predefined, and an output arrangement via which a manipulated variable that influences the actual speed of the vehicle is output based on the actual speed and the set point speed in order to influence the actual speed of the vehicle, and further requires that the control device includes "an enabling arrangement for enabling only the manipulated

variable to be calculated and output, respectively, if a descent of the vehicle has been detected; and wherein the control device includes an arrangement for detecting descent of the vehicle."

On page 4 of the answer, the examiner's explanation of the obviousness rejection reiterates the steps of method claim 1 and points to some portion of Sigl by column and line for each step. The examiner then asserts the following:

> Sigl performs some functions when the vehicle is traveling on a downhill. Therefore, Sigl detects when the vehicle is traveling on a descent. It can be read between the lines.

The examiner next reiterates the requirement set forth in dependent claim 2 on appeal and asserts that Sigl teaches such limitation. However, it does not appear that the examiner has made any attempt to indicate where in Sigl the elements of the device set forth in independent claim 8 on appeal are to be found.

Since there is no apparent indication of a difference between Sigl and appellants' claimed subject matter and no statement of obviousness, we are at somewhat of a loss to

understand the examiner's rejection under 35 U.S.C. § 103(a). It appears that the examiner may be of the view that Sigl inherently performs the method set forth in claims 1 and 2 on appeal, but has provided no clear explanation of why. In addition, the examiner has provided no explanation whatsoever as to why the device set forth in independent claim 8 on appeal would have been obvious to one of ordinary skill in the art at the time of appellants' invention based on the teachings of Sigl. Thus, we REMAND for further clarification of the exact nature of this obviousness rejection, some idea of what difference or differences the examiner believes exist, and for some indication on the examiner's part as why any such differences would have been obvious to one of ordinary skill in the art at the time of appellants' invention.

On September 22, 2003 appellants filed a reply brief (Paper No. 24). The reply brief includes 5 pages of argument and comments specifically targeting the portions of the disclosure in Sigl relied upon by the examiner in the answer and providing reasons why appellants believe the examiner has misconstrued or

misunderstood the disclosure of that patent. On September 28, 2003 appellants filed another paper said to be a supplemental reply brief (Paper No. 25). This paper includes yet another line of argument from appellants as to why the examiner's understanding of Sigl is in error. In response to the two reply briefs, the examiner sent out Paper No. 26 (mailed October 20, 2003) with the only guidance being the following statement therein

> Acknowladge [sic] of reply and supplement to the brief filed on 9/22/03 and 9/26/03. The [sic] case has been forwarded to the board of appeal and Interference.

Our problem is that the examiner has not actually indicated whether the reply briefs filed by appellants have been entered or not, and has not provided any indication that such papers were in any way considered by the examiner. Nor has the examiner provided us with any understanding of her position concerning the various arguments presented by appellants in the two reply briefs. Thus, we REMAND for the examiner to clearly indicate the status of the reply briefs, i.e. entry/non-entry. Moreover, given the detailed nature of appellants' arguments in the reply

briefs, we request that the examiner provide a response on the record to the arguments raised by appellants in the reply briefs.

A supplemental examiner's answer clarifying the issues discussed above will be necessary and is hereby authorized. It follows that appellants should have an opportunity to respond to any such supplemental answer by way of a further reply brief. Note, for example, 37 CFR § 1.193(b)(1) and (b)(2).

In addition to the foregoing, we suggest that the examiner provide serious consideration to the following prior art documents, with regard to both the currently rejected claims on appeal and the claims already indicated by the examiner to be allowed:

a) JP 61-35260

b) GB 2325716

c) JP 63-289360

d) JP 64-30959

Full consideration of the Japanese documents will, of course, require that a translation be obtained. While documents a and b above are already of record, we note that documents c and d are

mentioned in U.S. Patent 5,794,170, which is of record. Each of the documents noted above seeks to achieve essentially the same result as appellants and each uses a means for detecting whether the vehicle is traveling on a descent, along with actual vehicle speed and a predefined setpoint speed to calculate and control at least one manipulated variable based on the actual speed and the setpoint speed when the vehicle is detected as traveling on the descent.

This application, by virtue of its "special" status, requires immediate action, see MPEP § 708.01 (item D), Eighth Edition, Rev. 1, Feb. 2003. It is important that the Board of Patent Appeals and Interferences be promptly informed of any action affecting the appeal in this case.

REMAND TO THE EXAMINER

IRWIN CHARLES COHEN)
Administrative Patent Judge)
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) BOARD OF PATENT
NEAL E. ABRAMS)
Administrative Patent Judge) APPEALS AND
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